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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/248,513 05/24/94 SUGIMOTO

H 35.C10048

EXAMINER
HARTARY, J

ART UNIT PAPER NUMBER

2108

DATE MAILED: 07/02/96

E1M1/0702
FITZPATRICK, CELLA, HARPER & SCINTO
277 PARK AVENUE
NEW YORK, NY 10172

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 5/16/96 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-62 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-62 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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EXAMINER'S ACTION

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1. Claims 1-35 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because they are incomplete. They do not positively recite a plurality of inks or a recording medium. The claims are indefinite because terms used do not have an antecedent basis. For example, in Claim 1, the terms penetrability, low dye density, different dye, penetrability superior, high dye density are terms which lack an antecedent basis in the claims.

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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3. Claims 1-35 are rejected under 35 U.S.C. § 103 as being unpatentable over Matsumoto 4,860,026 in view of Suzuki 4,551,736 and Sugimoto 5,477,248. Matsumoto discloses (Figure 9) an ink jet apparatus for forming an image on recording medium 51 by using a plurality of ink discharge means 58-1 - 58-10 having a plurality of inks with different dye densities (thin, mid, thick). The claims further recite the penetrability of inks having different dye densities is different, and the ink having low dye density has superior penetrability to the ink having high dye density on the medium. Suzuki discloses ink jet inks with different dye densities can have different amounts of solvent and therefore different penetrability. Sugimoto discloses the use of different penetrability for inks in ink jet recording. It would have been obvious that the Matsumoto recording apparatus could have a plurality of inks with the penetrability claimed as a matter of forming images in a manner suggested by Suzuki and Sugimoto. The ink jet method of Claims 14-20 are suggested by the cited references.

4. Claims 36-62 are rejected under 35 U.S.C. § 103 as being unpatentable over Matsumoto 4,860,026 in view of Suzuki 4,551,736. The recorded article of Claim 36 would be suggested by the recorded sheet 51 of Matsumoto. Matsumoto discloses an ink jet recording apparatus (Figure 9) having plural

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discharge means 58-1 - 58-10 for recording on sheet 51. The plural inks have different dye densities (thin, mid, thick). Different dye densities could obviously have different penetrabilities as evidenced by Suzuki (col.6 lines 21-26).

5. Applicant's arguments filed May 16, 1996 have been fully considered but they are not deemed to be persuasive. It is argued that Suzuki (col.6 lines 29-31) does not reveal anything about penetrability. This argument is not persuasive. The yellow ink compositions of Suzuki differ in solvent content (99.3 and 97.0) thus providing different penetrability. Note Sugimoto col.1 lines 54-62. The features found in the dependent claims have not been specifically argued and thus, the merits of these claims will rise or fall with those of the independent claims.

6. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE

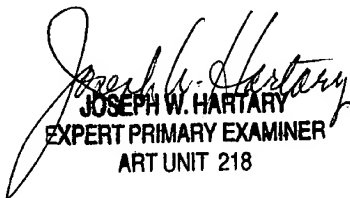
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MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph W. Hartary whose telephone number is (703) 308-3124.

 6/26
JOSEPH W. HARTARY
EXPERT PRIMARY EXAMINER
ART UNIT 218

JWH
June 26, 1996